

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of: Bledsoe *et al.*

Application No.: 10/600,751

Confirmation No. 5089

Filed: June 20, 2003

Art Unit: 1652

Examiner: David J. Steadman

For: STRUCTURE OF A GLUCOCORTICOID RECEPTOR LIGAND
BINDING DOMAIN COMPRISING AN EXPANDED BINDING POCKET AND
METHODS EMPLOYING SAME

Customer No.: 23347

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

This paper is submitted in response to the Office Action mailed June 2, 2005. Early examination of the application on the merits is earnestly solicited.

Claims 1-112 are pending in the present application. The Examiner has required restriction one of 12 groups, Group I (claims 1-21 and 30-37), Group II (claims 69, 111, and 112), Group III (claims 95-108), Group IV (claims 22-29), Group V (claims 38-45), Group VI (claims 46-54), Group VII (claims 55-68), Group VIII (claims 70-79), Group IX (claims 80-87), Group X (claims 88-94), Group XI (claim 109), and Group XII (claims 110). In addition, the Examiner has required Applicants to elect a single sequence selected from SEQ ID NO:6 and SEQ ID NO:8 if Group I, IV, V, VI, VII, IX, or X is elected, or a single sequence selected from SEQ ID NO:8 and SEQ ID NO:10 if Group VIII is elected.

Applicants provisionally elect with traverse to prosecute the claims of Group V, *i.e.* claims 38-45, drawn to a method for identifying a GR modulator, and further elect to prosecute these claims as directed to SEQ ID NO:6. Applicants expressly reserve the right to file divisional applications or take such other measures deemed necessary to protect the inventions in the remaining claims and sequences.

The Examiner is respectfully requested to reconsider the restriction requirement and examine Group V as directed to both SEQ ID NO:6 and SEQ ID NO:8. SEQ ID NO:8 differs from SEQ ID NO:6 by only one amino acid: the phenylalanine at residue 82 of SEQ ID NO:6 is substituted with serine at the corresponding position in SEQ ID NO:8. Because SEQ ID NO:6 and SEQ ID NO:8 are highly related, it is respectfully submitted that the search required to determine the patentability of Group V as directed to SEQ ID NO:8 is substantially similar to the search required to determine the patentability of these same claims as directed to SEQ ID NO:6.

Section 803 of the Manual of Patent Examining Procedure provides that there are two criteria to be met in order for restriction between patentably distinct inventions to be proper: "(A) The inventions must be independent . . . or distinct as claimed; and (B) There must be a serious burden on the examiner if restriction is required." MPEP § 803 further provides "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." Because the sequence set forth in SEQ ID NO:8 differs from the sequence set forth in SEQ ID NO:6 at only one residue, there would be no serious burden on the Examiner if these sequences were examined together.

Should the Examiner have any further questions or comments regarding the prosecution of this case, it is respectfully requested that the Examiner telephone the undersigned agent so that further examination of this application may be expedited.

Applicants believe that no fees are due in connection with the filing of this paper other than those specifically authorized herewith. However, should any other fees be deemed necessary to effect the timely filing of this paper the Commissioner is hereby authorized to charge such fees to Deposit Account No. 07-1392.

Respectfully submitted,

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